



3639

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TRANSMITTAL FORM

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|--|---|------------------------|-------------------|
| | | Application Number | 09/845,539 |
| | | Filing Date | April 30, 2001 |
| | | First Named Inventor | David P. Vellante |
| | | Art Unit | 3639 |
| | | Examiner Name | Fadey S. Jabr |
| Total Number of Pages in This Submission | 3 | Attorney Docket Number | ITC 2-001 |

ENCLOSURES (Check all that apply)

| | | |
|---|---|---|
| <input type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> After Allowance Communication to TC |
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| <input type="checkbox"/> After Final | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Proprietary Information |
| <input type="checkbox"/> Affidavits/declaration(s) | <input type="checkbox"/> Power of Attorney, Revocation | <input type="checkbox"/> Status Letter |
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| <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application | <input type="checkbox"/> Landscape Table on CD | |
| <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | | |
| <p>Remarks</p> <p>Response to Restriction Requirement</p> | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | | | |
|--------------|------------------------|----------|--------|
| Firm Name | Mueller and Smith, LPA | | |
| Signature | | | |
| Printed name | Diane E. Burke | | |
| Date | October 24, 2005 | Reg. No. | 45,725 |

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This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re Application of : David P. Vellante, et al.
Serial No. : 09/845,539
Filed: : April 30, 2001
For: : Method and System for Assessing and Quantifying the
Business value of an Information Technology (IT)
Application or Set of Applications
TC/AU : 3639
Examiner : Fadey S. Jabr
Attorney Docket No. : ITC 2-001

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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This is a response to the October 17, 2005 Office Action containing a restriction requirement.

It is noted that the restriction has been called for with respect to two inventions identified as Inventions I and II. Invention I includes claims 1-14 and 29-49, while Invention II includes claims 15-28. Applicant provisionally elects, with traverse, Invention I including claims 1-14 and 29-49.

Section 121 of the Patent Statute authorizes a requirement for restriction only when two or more independent and distinct inventions are claimed in one application. The two inventions identified above clearly are dependent in that each is related to the other in operation or effect. The Statute requires both independence and distinctness, not either, and provides such requirement in definite terms. The construction adopted by the Manual of Patent Examining Procedure assumes that the Statute authorizes restriction between inventions which are not independent and distinct, but which are either independent or distinct. It is Applicant's position that the plain meaning of the Statute defies such construction. For this reason, Applicant requests that the restriction requirement be withdrawn so that the claims in controversy may be prosecuted as a single invention.

Appln. No. 09/845,539
Response dated October 24, 2005
Reply to Office Action of October 17, 2005

Respectfully submitted,

Date: October 24, 2005

Diane E. Burke

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited on October 24, 2005 with the United States Postal Service as first class mail in an envelope addressed to:

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